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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,624	06/24/2003	Kazuto Ikemoto	396.42871X00	1111

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EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,624

Applicant(s)

IKEMOTO ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/15/05 have been fully considered but they are not persuasive.
2. The applicant argues that the combination of an ether solvent and an amide solvent are not specifically taught in the prior art. The applicant admits the prior art teaching both solvents, but argues that one would not be motivated to combine these two specific solvents.
3. The applicant further points to specific examples in the prior art showing that such a combination has not been performed. For instance, an example in Maruyama '285 has been cited in the specification as being an inferior composition.
4. It is not necessary for the prior art to specifically exemplify the applicant's claimed composition. Nor can the applicant rely on a specific example in the prior art but must read the prior art as a whole. The prior art is only required to provide one skilled in the art of cleaning a general teaching of the applicant's invention. Furthermore, the applicant's examples are not commensurate in scope with broadly claimed invention as the instant claims do not require the specific weight percentages exemplified.
5. In this instance, the prior art as a whole recites solvent lists which are not overly lengthy. Furthermore, the prior art directs one to combine solvents to form solvent mixtures (see page 12, line 1-3 of the applicant's remarks).
6. As such, the examiner is not convinced that one of ordinary skill in cleaning would not be capable of choosing two solvents from a relatively short list of aqueous solvents.

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7. Concerning the applicant's newly added limitation directed to the dielectric constant of the amide, it is unclear how this overcomes previous prior art rejections. The examiner has recited amides as disclosed on page 4 of the applicant's specification. It is not clear how these identical compounds recited in the specification and the prior art would possess differing properties. Nor has the applicant addressed the prior art with this concern in their remarks.

8. Thus the examiner maintains that physical properties such as the dielectric constant would be inherent to those amides in the prior art as those amides in the prior art are identical to those in the specification.

9. As such all previous rejections are maintained.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikemoto '410.

12. Ikemoto teaches glycol ethers and amides as rinsing agents when rinsing the fluorine compound from the surface a mixed composition containing the glycol ether, amide and fluorine would be obtained. Furthermore the broad range of ratios found in claim 16 would be inherent to this mixture.

13. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe ('169).

14. Concerning the newly added claims 15 and 16, Abe clearly teaches mixtures of solvents (see col. 4, lines 1-8) and teaches the use of the solvents in amounts ranging from 1-7% of the composition.

15. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Gotoh ('309).

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16. Concerning the newly added claims 15 and 16, Gotoh clearly teaches both the glycol ether and the amide solvent (see col. 5, lines 29-43) and the use of combinations of water soluble solvents (see col. 5, lines 41-42).

17. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama ('385).

18. Concerning the newly added claims 15 and 16, Maruyama teaches 72-80% water-soluble solvent. Maruyama clearly teaches "the organic solvent soluble in water can be used singly or as a combination of two ore more solvents."

19. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Torii ('862).

20. Concerning the newly added claims 15 and 16, Torri clearly teaches the combination of solvents in the statement "The oraganic solvent as the component (B) in the cleaning liquids of the invention may be used alone or in combination with at least one other."

21. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanabe ('274).

22. Tanabe teaches in claim 2 a composition containing DMSO and diethylene glycol monobutyl ether. Such small Markush groups demonstrate the combination.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory E. Webb
Primary Examiner
Art Unit 1751

gew